

JOUBERT
Application No. 10/562,264

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1, 5, 8, 13 – 18 and 24 – 28 are pending in the application, claims 19 – 22 having been withdrawn from consideration. Upon entry of this Amendment, independent claims 1 and 13 will be amended.

In the outstanding Final Office Action of January 5, 2009, the Examiner rejected claims 1 and 13 under 35 U.S.C. §112, second paragraph, as being indefinite, pointing to certain limitations in the claims as lacking sufficient antecedent basis, and, with regard to claim 1, also requiring a description of the structure that performs the recited engraving and the releasing of the projectile by the urging member. The Examiner also objected to claims 5, 8, 14-18 and 24-28 as being dependent upon rejected base claims 1 and 13. The Examiner is thanked, however, for indicating in the Final Office Action that claims 1 and 13 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph.

Turning to the Examiner's indefiniteness rejection of claims 1 and 13 under §112, second paragraph, it is unclear to the undersigned why the Examiner's states that the phrase "loading a projectile into a barrel of a gun" recited in the preambles of claims 1 and 13 has not been given any "patentable weight" because, in the Examiner's view, the preambles of claims 1 and 13 are statements of purpose or use and not limitations on which the bodies of such claims depend for completeness. 1/5/09 Final Office Action, page 2. It is respectfully submitted, that the Examiner's focus on the "patentable weight" of recitations in the claims' preambles relate to the scope of claims 1 and 13

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and not on the definiteness of the language of such claims. See, e.g., MPEP § 2111.02 "Effect of Preamble".

Rather, it is submitted that what is recited in the preamble of a claim has a definite bearing on whether a claim complies with the requirement of 35 U.S.C. §112, second paragraph, that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The majority of the reasons stated by the Examiner in the Final Office Action for rejecting claims 1 and 13 under §112, second paragraph, are a lack of a sufficient antecedent basis for several limitations recited in claims 1 and 13. See 1/5/09 Final Office Action, pages 2 and 3, paragraphs 2 – 4. The U.S. Patent Office Manual of Patent Examining Procedure ("MPEP") states, with regard to rejections under §112, second paragraph, based on a lack of antecedent basis, that:

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference.

MPEP § 2173.05(e) "Lack of Antecedent" (Emphasis added). The language in this section "the claim contains no earlier recitation or limitation" of or relating to a limitation argued to be indefinite suggests that the preamble of the claim can provide the required antecedent basis. This conclusion is buttressed by the test stated in the MPEP for determining whether a claim is indefinite under §112, second paragraph:

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In reviewing a claim for compliance with 35 U.S.C.
112, second paragraph, the examiner must consider the
claim as a whole to determine whether the claim apprises
one of ordinary skill in the art of its scope and, therefore,
serves the notice function required by 35 U.S.C. 112, second
paragraph, by providing clear warning to others as to what
constitutes infringement of the patent.

* * *

If upon review of a claim in its entirety, the examiner
concludes that a rejection under 35 U.S.C. 112, second
paragraph, is appropriate, such a rejection should be made
and an analysis as to why the phrase(s) used in the claim is
"vague and indefinite" should be included in the Office
action.

MPEP §2173.02 "Clarity and Precision" (Emphasis added).

Turning to the Examiner's specific reasons for rejecting claims 1 and 13 under §112, second paragraph, in paragraph 2 of the outstanding Final Office Action, the Examiner states that the limitation "the barrel" or "the said barrel" in such claims lacks sufficient antecedent basis in such claims. Similarly, in paragraph 3 of the Final Office Action, the Examiner states that the limitations "the chamber" and "the gun" lack sufficient antecedent bases in such claims. Finally, in paragraph 4 of the Final Office Action, the Examiner states that claims 1 and 13 fail to positively recite "a projectile", "a barrel", "a chamber", or "a gun".

The limitations of "the projectile", "the barrel" and "the gun" are now affirmatively recited in the body of claims 1 and 13 of the present application. The antecedent bases for all of these limitations appear in the preambles of claims 1 and 13. For the reasons discussed above, it is entirely appropriate for the Examiner to look to the entireties and, thus, the preambles of claims 1 and 13 in determining whether the limitations of "the

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projectile", "the barrel" and "the gun" recited in the bodies of these claims have sufficient antecedent bases so as to not be indefinite within the meaning of §112, second paragraph. Because these limitations are recited in the preambles of such claims, they have sufficient antecedent bases in such claims.

With regard to the limitation "the chamber", because this limitation is not recited in the preambles of claims 1 and 13 of the present application, such claims have been amended to recite -- a chamber --. Thus, it is believed that the Examiner's §112, second paragraph, rejection of claims 1 and 13 on the basis that the limitations "the projectile", "the barrel", "the gun" and "a chamber" lack sufficient antecedent bases in such claims should now be withdrawn.

With regard to the Examiner's assertion that claim 1 fails to define the structure that performs the engraving or how the projectile is engraved, it is noted that claim 1 has been amended to describe the "engraving" as a pre-existing engraving in the barrel of the gun. The pre-existing engraving recited in such claim would also be described as "rifling" in the barrel of a gun. Similarly, how the projectile is engraved is now described in amended claim 1 as occurring by reason of the projectile engaging, under its own momentum, the engraving in the barrel once it has been delivered into the chamber of the gun.

With regard to the Examiner's assertion that there is no device described for the urging member that would release the projectile as recited in claim 1, this limitation has now, per the Examiner's suggestion, been deleted from claim 1. As such, the

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Examiner's rejection of claim 1 under §112, second paragraph, on this basis, should also be withdrawn.

In view of the foregoing, it is believed that all of the claims remaining in the application, i.e., claims 1, 5, 8, 13 – 18 and 24 – 28, are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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